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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,561	08/31/2006	Shogo Marui	66043(70820)	3122
21874 7590 05/21/2008 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
CHANDRAKUMAR, NIZAL S				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
05/21/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,561

Applicant(s)

MARUI ET AL.

Examiner

NIZAL S. CHANDRAKUMAR

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) 13 and 15-22 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12, 14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-624)
Paper No(s)/Mail Date 04/03/2008, 08/31/2006
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-12 and 14 in the reply filed on 04/03/2008 is acknowledged. The traversal is on the ground(s) that examination of the all the groups together would not impose serious burden. This is not found persuasive because for the reasons of record.

The rejoinder option would be available when the base compound claim are deemed allowable.

The requirement is still deemed proper and is therefore made FINAL.

Claim 13, 15-22 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 04/03/2008.

This application contains claim 13, 15-22 drawn to an invention nonelected with traverse in the reply filed on 04/03/2008. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided

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the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-12, 14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. 6,974,806, US 5,482,967 and US 5,700,810. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the application and the claims of issued patent are drawn to the same lipid-rich plaque regressing chromenone derivatives.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 1-12, 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/500,839, 11/212,800 and 11/728,550. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both the applications are drawn to 7-azaindole compounds with similar substitutions.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 and dependent claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms 'optionally substituted' and 'hydrocarbon group' are vague and indefinite. These broad generalizations are further confusing because of the unclear description for such terms in the specification. For example paragraph [0017] recites one possibility for an optional substituent is 'an

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optionally substituted hydroxyl group'. Hydroxyl group is monovalent and thus does not additional substituent if attached, for instance on a hydrocarbon C.

Clear definition of variables, such as the one found in claim 5 for variable R group would overcome this rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

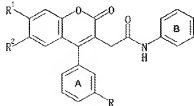
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

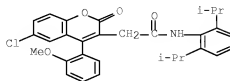
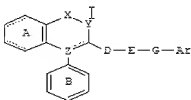
Claims 1-12, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Natsugari et al. (US 5482967 and US 5700810).

The instant claims are drawn to allegedly lipid-rich plaque regressing 2H-chromen-2-one derivatives of formula (I)



The optional substitutions on these rings as well as R1 and R2 include a wide variety of substitutions varying in properties such as size, molecular weight, lipophilicity etc. The important claim limitation is the substituent R which is a carboxyl group or a hydrocarbon chain substituted with a carboxyl group. The carboxyl group enables the formation of the claimed metal or amine salt.

Natsugari et al. teach compounds regulating blood lipid profile (excellent activity of inhibiting ACAT, lowering cholesterol in blood) of generic structure as well as specific 2H-chromen-2-one derivatives such as the one shown below:



Ring B of Natsugari et al. formula corresponds to Ring A of the instant formula. Natsugari explicitly defines preferred substituents on the ring B of his general formula which includes a carboxyl group or a hydrocarbon chain substituted with a carboxyl group.

The difference is that the instant claims are drawn to specifically to metal and amine salts of chromenone compounds consisting carboxylic acid groups, while Natsugari et al prior art includes such carboxylic acid compounds as some of many other possibilities.

One skilled in the art of drug discovery research aimed at discovering agents to modulate blood lipid profile, would be motivated to modify the 2H-chromen-2-one pharmacophore of Natsugari et al. with substituents such as salt forming carboxylic acid moieties with reasonable amount of success because aqueous solubility is inherent to carboxylic acid salt that enhances PK properties and because Natsugari et al. teaches such compounds would have lipid regulating property. Analog-design to modify solubility

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properties is routine to one of ordinary skill in the art of medicinal chemistry. The instantly claimed compounds would have been suggested and thus obvious to one skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nizal S. Chandrakumar whose telephone number is 517-272-6202. The examiner can normally be reached on 8.30 am – 5 pm Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867 or Primary Examiner D. Margaret Seaman can be reached at 571-272-0694. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nizal S Chandrakumar

/D. Margaret Seaman/

Primary Examiner, Art Unit 1625